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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Morgan

Serial No.: 09/933,494

Filed: August 20, 2001

For: **SYSTEM AND METHOD TO USE UNMODIFIED
OPERATING SYSTEM ON DISKLESS COMPUTER**

Art Unit: 2182

Examiner: Martinez

ARC9-2001-0079US1

January 5, 2004
750 B STREET, Suite 3120
San Diego, CA 92101RESPONSE TO OFFICE ACTIONCommissioner of Patents and Trademarks
Washington, DC 20231

Dear Sir:

This is in response to the Office Action dated December 29, 2003, rejecting all three independent claims (1, 10, and 19) and various dependent claims as being anticipated by Kedem et al., and rejecting various other dependent claims as being obvious in view of Kedem et al., alone or in combination with Kathail et al.

The error in the rejections is manifest and will be succinctly dealt with. It is alleged that while Kedem et al. fails to explicitly teach that its LDIM, used as the claimed adaptor, translates disk I/O requests to network requests, such is "inherent" in order "to handle requests from a CPU and to communicate to a remote server through a network". Unfortunately for the Examiner, Kedem et al. does not see it that way. Specifically, at, for example, col. 4, lines 52-64 (discussing embodiments in which there is no local disk drive), Kedem et al. explicitly require that *all read/write requests for data that are received by the LDIM*

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are transmitted to the RDIM. The fact that such disk requests are directly transmitted without the claimed translation is reiterated, by way of example, in the detailed description at col. 9, 34-36. If Kedem et al. required translation by the LDIM of the disk I/O requests to network requests, it is strange that Kedem et al. didn't mention it, since the LDIM is at the heart of Kedem et al.

Thus, while the Examiner may believe that Kedem et al. necessarily translates disk I/O requests to network requests (MPEP §2112 requires that to have an "inherent" feature, a reference must "necessarily" work in the allegedly inherent way), the evidence of record directly contradicts the Examiner's apparently incorrect conjecture. While it is not up to Applicant to guess just how Kedem et al. might directly send disk I/O requests to a network resource without requiring translation, Applicant offers the general observation that it is certainly possible to send untranslated data anywhere on a network, and that there is nothing in theory to prevent a receiving component from understanding the untranslated data. Thus, the conjecture that Kedem et al. necessarily translates disk I/O requests to network requests despite the inconvenient fact that Kedem et al. teaches no such thing, is on shaky ground. In any case, because the evidence of record directly contradicts the Examiner's finding of fact, the rejection cannot stand, see Dickinson v. Zurko, 527 U.S. 150 (1999), placing the U.S. P.T.O. under the Administrative Procedures Act, which makes clear that an agency that renders a finding of fact that is in direct opposition to the evidence of record is behaving arbitrarily and capriciously.

Prior art showings of support for all facts alleged to be "well-known" as part of the remaining rejections are hereby seasonably requested under MPEP §2144.03.


The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

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Respectfully submitted,



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JLR:jg

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